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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/231,625	01/14/1999	ROBERT BEACH	612	2840

26161 7590 04/30/2003

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BOSTON, MA 02110

EXAMINER

LEE, CHI HO A

ART UNIT	PAPER NUMBER
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2663

DATE MAILED: 04/30/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/231,625

Applicant(s)

BEACH ET AL

Examiner

Andrew Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-24 and 26-41 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

REC

1. The request filed 4/22/03 on for a RCE under 37 CFR 1.114 based on parent Application No. 09/231,625 is acceptable and a CPA has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 24, 32, and 38-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Re Claims 24 and 32 recite, "wireless communication server can concurrently operating with multiple access points utilizing different media types and/or data rates". Applicant provides ('625, 1: 16) as support. However, as specification supports different media types i.e., paging and voice, the specification lacks how the wireless communication server concurrently operates with the multiple access points utilizing different data rates.

Re Claim 38 recites "a wireless communication server analyzing network data to determine from a remote unit identification, a desired access point to transmit the data, the wireless communication server being adapted to select the desired access point

from a number of possible access points". Applicant provided support in specification page 8, lines 4-5. To achieve this function, the intelligent hub maintains a routing list of mobile units 12 and their associated access point. The specification supports the association of the "remote unit identification" with the "desired access point" since the intelligent hub maintain such association, however, the specification lacks the intelligent hub adapted to select the desired access point from number of possible access points. At most, the intelligent hub discloses a direct association between single remote unit identification to a single assesses point in the routing list, hence no selection of the possible access points for the "a remote unit identification".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 recites the limitation "the automatic association" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19-23, 26-28, 30, 31, and 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diepstraten et al U.S. Patent Number 5,991,287 in view of Eggleston et al U.S. Patent Number 5,958,006.

Re Claims 19, 34, 35, and 36, '287 Patent teaches in fig. 1, Server 20 (a wireless communication server); Access Point 41(one access point) connected to Server 20 wirelessly communicates data with MS 52 via WLAN IEEE 802.11 Air Interface protocol (See col. 2, lines 43-45) wherein the Server 20 is physically separate from the access points by a backbone 30 (See col. 3. lines 55 ~ col. 4, lines 1-30).

'287 Patent fails to explicitly teach, "the wireless communication server maintaining centralized filtering and forwarding of data to be transmitted to the remote units."

However, '006 patent teaches a user definable filter parameters data being transferred between the remote unit and server for filtering and forwarding of desired data transfer between the server and the remote (See col. 3, lines 1-15). One skilled in the art would have been motivated by '006 patent to include the filtering and forwarding function into the server of '287 patent to facilitate user defined parameters in the desired data transfer. Hence, by filtering email based on user-defined parameters, the types and amount of data being transferred are optimized (See col. 2, lines 1-5). Therefore, it would have been obvious to one ordinary skilled incorporate the teaching of '006 patent into the teaching of '287 Patent.

Re Claims 20 and 37, '287 Patent teaches the server is connected to the access point via a bus (conventional network element).

Re Claim 21, server 20 and the access point are connected over the bus 30 network (existing wired network).

Re Claim 22, refer to Claim 20, '287 in view of '006 fails to explicitly teach the existing wired network is an Ethernet network. Examiner takes official notice that IEEE 802 standard provides various operating speeds such as Ethernet 10Base-T or 100Base-T or higher rates. Hence, one skilled in the art would have been motivated to use a known wired Ethernet protocol to be adaptive to different operating speeds available to the existing bus network of '287 patent.

Re Claim 23, see fig. 1 of '287 wherein the connection between Server and the single access point via bus is a direct cable connection.

Re Claims 26, 33, fig. 2 of '006 teaches a Host Server 240 (one additional wireless communication server) coupled to the communication server 220 for providing data to wireless remote 201.

Re Claim 27, refer to Claim 26, the mailboxes within server 240 are associated with the plurality of wireless remotes. Each remote communicates with 240 via associated access points. Hence, when different remotes retrieve mailboxes, different access points are serviced.

Re Claim 28, WLAN operates in unlicensed ISM band (See col. 1, lines 19-22).

Re Claim 30, fig. 2 of '006 patent teaches the communication server communicates with the remote using packets. It is inherent that the packet includes an address (a remote unit identification).

Re Claim 31, refer to Claim 19, wherein the server is connected to the access point via a bus (one wired-network element).

Allowable Subject Matter

8. Claim 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

In combination with Claims 19 and 25, prior art fails to teach the wireless communication server includes at least one destination table relating remote units to access points.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent Number 5,339,316 teaches a WLAN in fig 1.

U.S. Patent Number 5,771,353 teaches a multi-protocol communication server 220.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Lee whose telephone number is 703-305-1500. The examiner can normally be reached on Monday to Friday from 8:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A handwritten signature in black ink, appearing to be 'AI' followed by a stylized flourish.

AI
April 28, 2003